

REMARKS

Claims 1-20 are pending in the present Application. Claim 20 has been withdrawn from consideration, and Claims 21-24 have been added, leaving Claims 1-19 and 21-24 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Requirement for Restriction Under 35 U.S.C. 121.

Applicants hereby confirm election of Claims 1-19, drawn to an electrical circuit laminate, without traverse.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-19 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,972,811 to St. Lawrence (herein, "St. Lawrence") in view of U.S. Patent No. 6,528,559 to Nakacho (herein, "Nakacho"). Applicants respectfully traverse this rejection on the grounds that the Examiner has failed to establish a prima facie case of obviousness.

St. Lawrence discloses an electrical substrate material comprising a prepreg comprising polybutadiene and polyisoprene, and conductive layers of copper foil laminated onto both faces of the prepreg. The prepreg further comprises a crosslinking agent, a filler, a curing agent, and a flame retardant, with the flame retardant further described as bromine-containing (col. 5 lines 14-15; and col. 8, lines 23-29). St. Lawrence does not disclose magnesium hydroxide as a flame retardant, but use of a bromine-containing fire retardant (col. 2, lines 33-36).

Nakacho discloses crosslinked phenoxyphosphazene compounds as flame-retardants for synthetic resins, teaching that they do not impair the mechanical properties or heat resistance of the resin (col. 2, lines 59-63). Nakacho also cites magnesium hydroxide in the background art as an example of a halogen-free flame retardant (col. 1, lines 43-44). However, Nakacho specifically teaches away from the use of inorganic metal hydroxides in the large amounts needed to provide a sufficient level of flame retardancy, as large amounts of metal hydroxides impair the inherent (e.g., mechanical) properties of synthetic resins (col. 1, lines 55-58). Nakacho therefore teaches away from the present claims, which require the use of magnesium hydroxide as a flame

retardant at about 20 to about 50 percent by weight in a polybutadiene or polyisoprene resin system.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). In this instance, there is thus no suggestion or motivation to combine references, and there is certainly no expectation of success in so doing. Rather, Nakacho teaches that use of amounts of inorganic metal hydroxides sufficient to confer flame retardance are not desirable. Applicants therefore respectfully request the Examiner withdraw the rejection and place the claims in condition for allowance.

New Claims

In addition, Claims 21-24 have been added to further claim the invention. Antecedent basis for Claim 21 is found at least at paragraph [0014] of the specification. Antecedent basis for Claims 22-24 is found at least at paragraph [0032] of the specification. New Claims 21-24 are believed patentable as they depend from allowable Claim 1.


It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

RGP-0088

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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